

## **REMARKS/ARGUMENTS**

### **Allowable Subject Matter**

The Applicant notes that the Examiner has indicated that the allowability of the claims is withdrawn in view of the newly discovered references. Accordingly, the Applicant responds as follows:

### **Obviousness - Section 103(a) Rejection**

The Examiner has rejected claims 1-35 as being obvious over Baker, Jr. et al. (4,723,744) in view of Cramer (2,613,389). The Applicant respectfully requests the Examiner to reconsider and remove this rejection for the points, authorities and arguments set forth below. In summary, the rejection based on Baker in view of Cramer should be removed because: (1) There is no motivation, teaching, suggestion or incentive to make the combination; (2) Cramer is art outside of the art field of this invention and of Baker, and should not be considered; and (3) even though there has been a long felt need for an invention such as this claimed invention since before Baker was granted in February of 1988, no such invention has been made until this one.

An invention which satisfies a long felt need which has not yet been fulfilled is clearly not obvious even if an Examiner can find non-analogous art or art outside of the field which the Examiner believes adds the missing elements, especially when the underlying primary reference does not even recognize the problem addressed by this invention.

Firstly, the law requires much more than merely finding two or more references which purport in combination to contain all the elements; instead the law requires that the primary reference must provide some suggestion, teaching or incentive in the prior art reference expressly or perhaps inherently, to make the combination. Absent the suggestion, teaching or incentive in the prior art, the prior art references are not to be combined and is not obvious.

If in looking at the primary prior art reference, the reference does not recognize or identify the problem(s) solved by this invention, then there can inherently be no incentive to combine it with another reference. While the Baker 744 reference does provide a camper support, it is the type of support which actually results in one of the problems which this invention is directed to because it requires the user to physically get under the camper and retrieve the structure from under the camper when the camper is lifted. Paragraphs [0006] and [0007] of this patent application provide:

[0006] It is difficult and sometimes dangerous to crawl underneath the camper while it is only supported by the legs or stands, and properly move all of the blocks into the desired position. This normally requires the owner to lift the structures while in a bent and prone position, creating a higher risk of injury to move the blocks under the camper.

[0007] It is therefore an object of this invention to provide a mobile camper support system which may easily be moved underneath the camper to provide solid support for the camper, and then again be easily removed.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO “failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

It is therefore respectfully submitted that the combination of Baker with Cramer does not satisfy the requirement to establish a *prima facie* combination.

Second, looking to a foot caster in Cramer is outside of the field and not a proper or sufficient combination on that basis either. The MPEP also requires that in order for the patent office to rely on a reference as a basis for rejection of an applicant’s invention, the **reference must be in the field of applicant’s endeavor**. MPEP §2141.01(a) (8<sup>th</sup> ed., rev. no. 3, vol. 2) *citing In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (emphasis added). In this case, a designer of a heavy duty camper support would not look in the lightweight foot and spring supported caster field to support a valuable and very heavy camper which may be expected to additionally have people therein. The first paragraph of Cramer indicates that Cramer relates to a caster-mounted step

ladder. So while this invention is primarily a camper support designed primarily to support substantial weight, with some additional elements to allow it to be inserted and removed, more easily, i.e. to address problems that were wholly unrecognized in the Baker reference, but which are created by the nature of the Baker reference (it is heavy and must somehow be inserted and removed into a difficult location). The Cramer device on the other hand is primarily a mobile, lightweight step ladder, not as a support for something heavy and which may be used as such on a longer term basis.

Third, the Baker patent reference was issued in 1988. This patent application recognizes the problems associated with Baker devices, and this invention provides such a solution. The problem has been present at least since Baker issued, but yet there is no solution in this field of record. In cases where there is a long-felt need such as this, with no invention providing such a solution like this invention does, the invention is not obvious or the combination would have been made before – but is has not been.

The Examiner in rejecting the method claims of claims 32-35, asserts that the combination of Baker in view of Cramer inherently teaches the method of claims 32-35. In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either

effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

For at least all the reasons set forth above, the Applicant asserts that the application is in position to proceed to allowance.

### **Prior Art Made of Record and Not Relied Upon**


The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

### **Conclusion**

Applicant therefore submits Claims 1-35 are in a position to proceed to allowance.

Respectfully submitted,

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